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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,632

01/26/2004

Raymond Anthony Joao

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EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

01/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,632	<b>Applicant(s)</b> JOAO, RAYMOND ANTHONY	
	<b>Examiner</b> VALERIE LUBIN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/26/04 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1-20 are pending

For reference purposes, the document paper number is 20090106

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Independent claims 1, 8 and 15 are directed to apparatuses comprising a processor, a display device and an output device, but also recite method steps performed by the processor such as generating data. The claims are indefinite because they recite both apparatuses and method steps. Second, claims 1 and 8 recite processing a first set of data, but later disclose that the processor generates a fourth set of data which is the equivalent of the first set of data used. It is unclear, how the first and the fourth set of data are different and how one can be used the generate itself.

Claims 2-7, 9-14 and 16-20, as dependents of claims 1, 8 and 15 and reciting similar language, are rejected under the above analysis.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-10, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham U.S. Patent No. 5,537,315.

7. In claim 1, Mitcham recites an apparatus comprising a processor that processes insurance data and generates data concerning an insurance policy or premium based on the processed data, and at least one of a display device and an output device (Col. 2 lines 35-36). Mitcham also discloses data regarding information for generating insurance policy or premium information containing information regarding the entity to be leased and driving history of a leasing entity (Fig. 5-13).

Mitcham does not specifically recite that the insurance policy information is for excess wear and tear; however, this information is merely directed to the intended use of the data generated and it has been held that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone" (-MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claims 2, 3, 5, 8-10, 14-17 are rejected under the analysis of claim 1.

8. Claim 6 is rejected, as Mitcham discloses an input device (Col. 1 lines 28-33; col. 2 lines 35-36; col. 3 lines 34-37).

Claims 13 is rejected under the analysis of claim 6,

9. Claim 7 is rejected, as Mitcham recites a receiver and transmitter for communicating data with a remote communication device (Fig. 1; col. 3 lines 35, 53-61).

10. Claims 4, 11, 12, and 18- 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham U.S. Patent No. 5,537,315 in view of Minturn U.S. Patent No. 5,692,501.

11. With regards to claim 4, Mitcham recites a processor generating insurance information (Fig. 13). He does not disclose the insurance information containing rebate incentive data; however, Mintum does disclose incentive features for insurance premiums (Abstract). It would have been obvious to one of ordinary skill in the art to combine the teachings of Mitcham and Mintum to provide a rebate incentive feature in order to attract and retain more customers.

Claims 11 and 18 are rejected under the analysis of claim 4.

12. For claim 12, Mitcham recites a processor that generates insurance and premium information (Fig 13). He does not disclose determining an amount of an insurance premium to be refunded; however Mintum discloses reducing premiums based on an incentive factor (Abstract; col. 9 lines 53-54). It would therefore have been obvious to one of ordinary skill to combine the teachings of Mitcham and Mintum to have the processor determine the amount

of premium reduction based on the incentive provision in order to present the adjusted premium to the user and increase customer retention.

13. For claim 19, Mitcham and Mintum do not specifically recites identifying a credit derivative; however, systems to do so were old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of the prior art in order to provide additional value to customers.

Claim 20 is rejected under the analysis of claim 19.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Atkins U.S. Patent No. 5,644,727 discloses refunds and rebates, and a systems that identifies and offers derivative products.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626